

Notice of Allowability

Application No.

10/021,373

Examiner

Kathleen A. McNelis

Applicant(s)

BERGER ET AL.

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Supplemental Remarks filed 7/24/06.
2. ☒ The allowed claim(s) is/are 16-31.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

Claims Status

Claims 16-31 remain for examination.

Terminal Disclaimer

The terminal disclaimer filed on 3 July 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent number 5,835,524 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Status of Previous Rejections

The previous rejections under 35 U.S.C. 103(a) of:

- Claims 16-25, 28, 29, 31 and 32 under 35 U.S.C. 103(a) as being unpatentable over Berger et al. (U.S. Pat. No. 5,835,524) in view of Eichberger et al. (U.S. Pat. No. 6,524,362), or
- Claims 16-25, 28, 29, 31 and 32 under 35 U.S.C. 103(a) as being unpatentable over Eichberger et al. (U.S. Pat. No. 6,524,362) in view of Berger et al. (U.S. Pat. No. 5,835,524), or
- Claims 26 and 27 under 35 U.S.C. 103(a) as being unpatentable over Berger et al. (U.S. Pat. No. 5,835,524) in view of Eichberger et al. (U.S. Pat. No. 6,524,362) or Eichberger et al. (U.S. Pat. No. 6,524,362) in view of Berger et al. (U.S. Pat. No. 5,835,524) and further in view of Usher et al. (U.S. Pat. No. 5,827,474), or
- Claim 30 under 35 U.S.C. 103(a) as being unpatentable over Berger et al. (U.S. Pat. No. 5,835,524) in view of Eichberger et al. (U.S. Pat. No. 6,524,362) or

Eichberger et al. (U.S. Pat. No. 6,524,362) in view of Berger et al. (U.S. Pat. No. 5,835,524) and further in view of Roth (U.S. Pat. No. 5,641,336) are withdrawn in view of applicant's statement filed 7/24/2006 that U.S. Pat. No. 5,835,524 to Berger et al. was commonly owned or subject to an obligation of assignment to Voest-Alpine Industrieanlagenbau GmbH at the time the invention of the present application was made.

The previous rejection of claims 16 and 32 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,835,524 in view of U.S. Pat. No. 6,524,362 is withdrawn in view of the terminal disclaimer filed July 03, 2006.

Allowable Subject Matter

Claims 16-31 are allowed.

The following is an examiner's statement of reasons for allowance:

The terminal disclaimer filed on 3 July 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent number 5,835,524 is sufficient to overcome the previous rejection of claims 16 and 32 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,835,524 in view of U.S. Pat. No. 6,524,362.

The statement filed 7/24/2006 that U.S. Pat. No. 5,835,524 to Berger et al. was commonly owned or subject to an obligation of assignment to Voest-Alpine Industrieanlagenbau GmbH at the time the invention of the present application was made is sufficient to overcome the previous rejections under 103(a) relying upon Berger et al. (listed above in Status of Previous Rejections).

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen A. McNelis whose telephone number is 571 272 3554. The examiner can normally be reached on M-F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KAM
9/12/2006



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